

REMARKS

At the time the Office Action was mailed on March 5, 2007, claims 1-23 were pending.

Claims 1, 11, 16, and 23 are currently amended.

Claims 10, 13, and 18 are presently canceled.

Thus, claims 1-9, 11-12, 14-17, and 19-23 remain pending.

Applicants and their attorney thank the Examiner for accepting the previously-filed response and, as a result, withdrawing the objections to the abstract and specification.

Rejections under 35 U.S.C. § 103

Claims 1-9, 11-12, 14-15, and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Case Western Reserve University, "Introduction to HTML" (CWRU) in view of Ayers, "AbiWord's Potential" (Ayers) and Rohr, "RE: Styles Again" (Rohr).

Applicants currently amend claim 1 to recite subject matter that applicants understand to be allowable as indicated in the Office Action at Page 10 and as explained below. Applicants submit that this amendment renders moot the rejection of claim 1. Correspondingly, because claims 2-9 depend from and apply additional limitations to claim 1, claims 2-9 are allowable for at least the same reasons for which claim 1 is allowable. Thus, applicants submit that the amendment to claim 1 also renders the rejection moot with regard to claims 2-9. Applicants respectfully submit that the rejection under 35 U.S.C. § 103(a) of claims 1-9 should be withdrawn, and that claims 1-9 are in condition for allowance.

Similarly, applicants currently amend claim 11 to recite subject matter that applicants understand to be allowable as indicated in the Office Action at Page 10 and as explained below.

Applicants submit that this amendment renders moot the rejection of claim 11. Correspondingly, because claims 12 and 14-15 depend from and apply additional limitations to claim 11, claims 12 and 14-15 are allowable for at least the same reasons for which claim 11 is allowable. Thus, applicants submit that the amendment to claim 11 also renders the rejection moot with regard to claims 12 and 14-15. Applicants respectfully submit that the rejection under 35 U.S.C. § 103(a) of claims 11-12 and 14-15 should be withdrawn, and that claims 11-12 and 14-15 are in condition for allowance.

Applicants also currently amend claim 23 to recite subject matter that applicants understand to be allowable as indicated in the Office Action at Page 10 and as explained below. Respectfully, this amendment renders moot the rejection of claim 23. Applicants thus submit that the rejection under 35 U.S.C. § 103(a) of claim 23 should be withdrawn, and that claim 23 is in condition for allowance.

Claims 16-17 and 19-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over CWRU in view of Ayers, Rohr, and Lemay, "Teach Yourself Web Publishing with HTML in 4 to 14 Days, Professional Reference Edition" (Lemay).

Applicants currently amend claim 16 to recite subject matter that applicants understand to be allowable as indicated in the Office Action at Page 10 and as explained below. Applicants submit that this amendment renders moot the rejection of claim 16. Correspondingly, because claims 17 and 19-22 depend from and apply additional limitations to claim 16, claims 17 and 19-22 are allowable for at least the same reasons for which claim 16 is allowable. Thus, applicants submit that the amendment to claim 16 also renders the rejection moot with regard to claims 19-

22. Applicants respectfully submit that the rejection under 35 U.S.C. § 103(a) of claims 1-9 should be withdrawn, and that claims 1-9 are in condition for allowance.

However, notwithstanding that the amendments render the rejections moot, applicants feel compelled to traverse the rejections. Applicants submit that the foregoing rejections fail to present a *prima facie* case of obviousness because neither of the combinations of references recites all of the limitations recited in the claims as required by the Manual of Patent Examining Procedure. *See* MPEP § 706.02(j) (“the prior art reference (or references when combined) must teach or suggest all the claim limitations”). Respectfully, Ayers fails to teach what the Office Action asserts it teaches, and the combinations using Ayers thus fail to teach all of the limitations recited in independent claims 1, 11, 16, and 23.

Specifically, Ayers fails to teach all of the limitations of claims 1, 11, 16, and 23 because Ayers cannot possibly teach or suggest both “internally representing an application document in an application, wherein the internal representation is in a format that is native to the application” and “mapping the determined properties of the list into at least one of a markup language element . . . and storing the mapped properties of the list in the markup language document.” As expressly stated by the Office Action, Ayers teaches a system in which “An *.abw file [the standard file format of the word processor described by Ayers] *is written in XML and thus is also in ASCII format; the files can be read by any text editor.*” (Ayers; Page 2, Paragraph 4, cited by the Office Action on Page 4; emphasis added). If Ayers’s storing of its documents natively in XML and ASCII is considered “internally representing an application document in an application,” then it cannot also teach “mapping the determined properties of the list into at least

one of a markup language element . . . and storing the mapped properties of the list in the markup language document.”

To find that Ayers teaches all those limitations fails to give effect to the limitations recited in the claim, because if Ayers’s documents already are stored in XML, there would not and could not be any mapping into a markup language and storing in a markup language. In fact, because Ayers expressly describes storing documents in these virtually universal standard file formats, Ayers teaches away from “mapping the determined properties of the field into at least one of a markup language element . . . and storing the mapped properties of the field in the markup language document.” Thus, applicants respectfully submit that the Office Action fails to present a *prima facie* case of obviousness. As a result of the amendments described below and the shortcomings of Ayers, applicants request that the rejection under 35 U.S.C. § 103 be withdrawn against all of the pending claims.

Allowable Subject Matter

Claims 10, 13, and 18 were objected to as being dependent upon a rejected base claim. However, the Office Action indicates the claims would be allowable if rewritten in independent form including the limitations of the base claim from which each depends. Applicants hereby amend claim 1 to recite what applicants understand to be the allowable subject matter recited in claim the limitations of allowable claim 10. Applicants also hereby amend both claim 11 to recite what applicants understand to be the allowable subject matter recited in claim 13 and claim 16 to recite what applicants understand to be the allowable subject matter recited in claim 18. Finally, applicants amend claim 23 to recite limitations corresponding to those now included in

claims 1, 11, and 16. Applicants respectfully request that each of the independent claims now recite allowable subject matter and, thus, are in condition for allowance.

Applicants wish to clarify what they mean by “recite what applicants understand to be the allowable subject matter.” Specifically, claims 10, 13, and 18 each recite the following substantive limitation:

[W]herein the markup language document is manipulated on a server to substantially reproduce the list of the word-processing document notwithstanding the presence of an application that generated the markup language document.

Without wanting to put words in the Examiner’s mouth, applicants infer that the Examiner’s allowance of claims 10, 13, and 18 is premised on the fact that the markup language document is capable of being manipulated on a server or another system on which the application that created the document is not installed. This underscores the portability of the document, more so than the server actually manipulating the markup language document.

Applicants have amended the independent claims to recite the subject matter understood to be allowable. Claim 1 as amended, is reproduced below as an example:

1. (Currently Amended) A method for representing list information in a markup language document, comprising:
internally representing an application document in an application, wherein the internal representation is in a format that is native to the application and the internal representation comprises unique properties for describing lists of data within the document, wherein the unique properties are defined by the application;
determining one or more unique properties corresponding to a list that relates to at least one section of the application document;
mapping the determined properties of the list into at least one of a markup language element, an attribute, and/or a value; and
storing the mapped properties of the list in the markup language document, wherein the markup language document is manipulable on a system including one of a server and another system to substantially reproduce the list without using the application that generated the markup language document.

Applicants respectfully submit that claim 1 as amended recites the allowable subject matter previously recited in claim 10. Claim 10 is presently canceled. Thus, applicants submit that claim 1, as well as claims 2-9 which depend from claim 1, are in condition for allowance.

In addition, applicants also have amended claim 11 to recite the allowable subject matter previously recited in claim 13. Claim 13 is presently canceled. Applicants submit that claim 11, as well as claims 12 and 14-15 which depend from claim 11, are in condition for allowance.

Applicants also have amended claim 16 to recite the allowable subject matter previously recited in claim 18. Claim 18 is presently canceled. Applicants submit that claim 16, as well as claims 17 and 19-22 which depend from claim 16, are in condition for allowance.

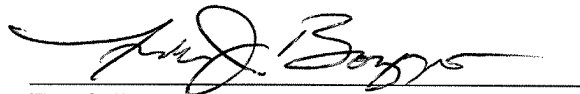
Finally, applicants also have amended claim 23 to recite the allowable subject matter. Thus, applicants submit that claim 23 also is in condition for allowance.

CONCLUSION

In view of the foregoing amendments and remarks, all pending claims are believed to be allowable and the application is in condition for allowance. Therefore, a Notice of Allowance is respectfully requested. Should the Examiner have any further issues regarding this application, the Examiner is requested to contact the undersigned attorney for the applicants at the telephone number provided below.

Respectfully submitted,

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